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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,350	07/14/2003	Pijush K. Dewanjee	PU2163	1349

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CALLAWAY GOLF COMPANY
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EXAMINER

BUTTNER, DAVID J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/604,350	DEWANJEE, PIJUSH K.	
	Examiner	Art Unit	
	David Buttner	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

This action is supplemental to that mailed 1/10/05 in order to include an omitted rejection. The response period is restarted.

The "hexamethylene diisocyanate" of claims 5-15 do not have basis in the parent applications. The effective filing date for these claims is 7/14/03. The methylene bis (chlorodiethyl) aniline of claims 1-4 does not have basis in 9-562782 or 9-295635. The effective filing date for these claims is 10/25/01.

Applicant must update the status of the parent applications at the beginning of the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The nomenclature of applicant's methylenebis-(3-chloro 2,6-diethyl)-aniline is believed improper. The last parenthesis should follow "aniline" because there are two aniline groups present for the curing agent used by applicant (LONZACURE paragraph 57 of spec). This is confirmed by Rosenberg (paragraph 67) and Wu (col 7 line 45).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Iwami 2002/0052251.

Iwami exemplifies (#I,II,II,IV,VI) golf ball covers of polyurethane prepolymer cured with MCDEA. MCDEA is applicant's curing agent. The prepolymer can be based on a polyether such as polyoxypropylene glycol (paragraph 27) and diisocyanates such as toluene diisocyanate (paragraph 25).. The prepolymers have an NCO content of several percent (see table 2 footnotes). Even if the number of choices for curing agent, polyether, isocyanate etc are too numerous to justify anticipation, any combination of listed elements would have been prima facie obvious.

Claims 5 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Iwami 2002/0052251.

Iwami exemplifies (#I,II,II,IV,VI) golf ball covers of polyurethane prepolymer cured with MCDEA. MCDEA is applicant's curing agent. The prepolymer can be based on a polyether such as polyoxytetramethylene glycol (paragraph 27) and diisocyanates such as hexamethylene diisocyanate (paragraph 25). Even if the number of choices for curing agent, polyether, isocyanate

Art Unit: 1712

etc are too numerous to justify anticipation, any combination of listed elements would have been prima facie obvious.

Claims 1 and 3 rejected under 35 U.S.C. 103(a) as obvious over Peter '313.

Peter suggests golf ball covers made from diisocyanate, polyether based on propylene oxide and amine chain extender (abstract). The diisocyanate can be toluidine diisocyanate (col 7 line 7) and the amine be MCDEA (col 10 line 18). The material can be polymerized using the prepolymer method (example 2). Peter does not placing any "surface geometry" on the ball ball, but dimpling is a well known cover configuration for golf balls. It would have been obvious to dimple Peter's ball for the expected effect.

Claims 5 and 9 rejected under 35 U.S.C. 103(a) as obvious over Rosenberg 2002/0203771.

Rosenberg exemplifies (#4) and elastomer from a HDI/PTMEG prepolymer cured with MCDEA. This is the material of applicant's claim 5. It is useful in golf ball covers (abstract). Rosenberg does not placing any "surface geometry" on the ball ball, but dimpling is a well known cover configuration for golf balls. It would have been obvious to dimple Rosenberg's ball for the expected effect. Also note Diethyl toluenediamine can be used as a curing agent (ie chain extender see claim 24 of Rosenberg).

Claims 1-11,14 and 15 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wu '261.

Wu suggests urethane covered golf balls (abstract). The urethane is made from a urethane prepolymer and a curative. The prepolymer can be based on a polyether such as PTMEG or polyoxypropylene glycol (col 20 line 60) and a diisocyanate such as toluene diisocyanate or

hexamethylene diisocyanate (col 20 line 1-3). The prepolymer has 2.5 –7.5% NCO groups (col 7 line 59). The curative can be MCDEA (col 22 line 3), diethyltoluene diamine (col 21 line 59) and mixtures thereof (col 22 line 5). An ionomeric inner cover can be present (col 8 line 20). The cover is 0.02-0.04 “ thick (col 18 line 15) and has a shore D hardness of 30-60 (col 26 line 18). The overall ball compression is 60-100 (col 24 line 60).). Even if the number of choices for curing agent, polyether, isocyanate etc are too numerous to justify anticipation, any combination of listed elements would have been prima facie obvious.

Claims 1-12,14 and 15 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Voorheis 2003/0064826.

Voorheis suggests urethane covered golf balls (abstract). The urethane is made from a urethane prepolymer and a curative (paragraph 63). The prepolymer can be based on a polyether such as PTMEG or polyoxypropylene glycol (paragraph 50) and a diisocyanate such as toluene diisocyanate or hexamethylene diisocyanate (paragraph 48). The curative can be MCDEA, diethyltoluene diamine and mixtures thereof (paragraph 54). An ionomeric inner cover can be present (col 8 line 20). The cover is 0.02-0.04 “ thick (paragraph 28) and has a shore D hardness of 30-40 (paragraph 76). The overall ball compression is 60-100 (paragraph 75). The core has a compression of 50-70 (paragraph 78). Even if the number of choices for curing agent, polyether, isocyanate etc are too numerous to justify anticipation, any combination of listed elements would have been prima facie obvious.

Claims 1-11,14 and 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Wu '261 or Voorheis 2003/0064826 in view of Rosenberg 2003/0203771.

Art Unit: 1712

As explained above, Wu and Voorheis suggest applicant's preferred cover but does not exemplify its use. Rosenberg actually produces applicant's preferred urethane cover and touts its properties. It would have been obvious to use this urethane as Wu's cover for the expected advantages.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 3 rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6592472. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6592472. Although the conflicting claims are not identical, they are not patentably distinct from each other because the

Art Unit: 1712

patent also claims golf ball covers of urethane prepolymer cured with methylene bis(chlorodiethyl aniline).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAVID J. BUTTNER
PRIMARY EXAMINER

David Buttner



1/18/04